

**REMARKS/ARGUMENTS:**

Reconsideration of the above identified application is respectfully requested.

In the Office action dated March 31, 2005, claims 6 and 21 are objected to as being of improper dependent form. Claims 1-17 and 21-23 are rejected under 35 U.S.C. §§102(a)/(b) as being anticipated by, or alternatively under 35 U.S.C. 103(a) as being obvious over U.S. Patent Publication No. 2003/0095981 of Wong et al. (hereinafter “Wong”) or U.S. Patent No. 6,440,420 to Liu et al. (hereinafter “Liu”).

In response to the objections, Applicants have canceled claim 6 and amended claim 21 to be correctly dependent on claim 2. Also, in response to the election/restriction, claims 24-29 are withdrawn. In addition, new claims 30-35 are added, which are fully supported by the specification, particularly in case studies 1-6. No new matter has been introduced.

Applicants also acknowledge safe receipt of the “Notice of References Cited” (Form PTO-892).

With respect to the claim rejections, Applicants have amended claim 1 to add a limitation that “said oleaginous substances are extracted from sporoderm-broken spores of *Ganoderma Lucidum* by an SCF-CO<sub>2</sub> method,” which is supported by the specification at on page 11, lines 6-23 to page 12, lines 1-2, to further clarify the invention. Applicants respectfully submit that the amendment of claim 1 has overcome the rejections for reasons set forth below:

***Election/Restrictions***

The Examiner’s office action states that the restriction requirement is deemed proper and therefore made final, and Applicants’ election with traverse of Group 1, claims 1-23, is acknowledged.

In this response, Applicants expressly submit that Applicants reserve any right to file continuing application(s) directing to any of the non-elected subject matter or request a reunion of the non-elected claims with the elected claims upon allowance of the subject application.

***Claim objection***

Claim 6 is objected to for failing to further limit the claim scope. Claim 21 is objected to for being dependent on itself.

In response to the objection, Applicants have cancelled claim 6 and corrected the dependency of claim 21 to claim 2.

***Claim rejection under 35 U.S.C. §102(a)/(b)***

Claims 1-17 and 21-23 are rejected as being anticipated by Wong or Liu.

Applicants respectfully traverse the rejection.

To anticipate a claim, each and every element of the claim must be taught, either expressly or inherently, in a single prior art reference. See e.g., *Verdegaal Bros. v. union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”).

The amended claim 1, which is the only independent claim in the present claimed invention, contains the following elements: (1) the external preparation contains oleaginous substances extracted from sporoderm-broken spores of *Ganoderma Lucidum*; (2) the external preparation is to be applied to the external skin of a human; and (3) the oleaginous substances are extracted by an SCF-CO<sub>2</sub> method.

Wong discloses processes to obtain from *Ganoderma lucidum* the pharmaceutically active fractions which have optical absorbance at about 200-280 nm and preparations containing the fractions. Wong does not teach nor disclose that its active fractions from *Ganoderma lucidum* contain oleaginous substances, that the oleaginous substances are extracted from the sporoderm-broken spores of *Ganoderma lucidum*, nor did he disclose the use of the SCF-CO<sub>2</sub> method to extract the oleaginous substances. In fact, Wong extracts from a homogenate of the fruiting body, mycelia or spores of *Ganoderma lucidum* with doubly distilled water or phosphate buffered saline (Wong, paragraphs 30, 31, 32, 75, and 79). These aqueous solutions are unlikely to extract oleaginous substances of *Ganoderma lucidum* as the oleaginous substances are generally insoluble in water (Applicants' specification, page 3, lines 13-14). Therefore, Wong does not anticipate claim 1 or its dependent claims.

In Liu (Applicant's own invention), a method for extracting oleaginous substances from sporoderm-broken *Ganoderma* spores has been disclosed (Applicants' specification, page 5, line 19 to page 6, line 5). However, contrary to the Examiner's allegation, Liu does not disclose any external preparation and application of the oleaginous substances to the external skin of a human. Thus, Liu does not anticipate claim 1 or its dependent claims.

***Claim rejection under 35 U.S.C. §103(a)***

Claims 1-17 and 21-23 are alternatively rejected as being obvious over Wong or Liu.

Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). Also the teaching or suggestions to make the claimed combination and the reasonable expectation of

success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Aforementioned reasons are further incorporated here by reference. Neither Liu nor Wong teach any external preparation of oleaginous substances of *Ganoderma* spores to skin, as Wong's *Ganoderma lucidum* are not oleaginous, and Liu does not teach the application of the oleaginous substances to external skin. Thus, there is no motivation nor suggestion for a skilled artisan to combine Wong and Liu, and there can be no reasonable expectation of success that the combined teachings would work, particularly since Wong teaches away from applying any oleaginous substances of *Ganoderma lucidum* to skin. Thus, Wong or Liu does not render the claimed invention obvious.

Furthermore, Applicants would like to point out that none of the properties of Applicants' external preparation to the skin, including smoothening, reducing wrinkles, age-defiance, reducing pigmentation, lessening skin inflammation, and/or alleviating skin irritation, as claimed in new claims 30-35, are taught nor disclosed in Liu or Wong. Thus, new claims 30-35 are also patentable over Wong and Liu.

In view of the foregoing, the objection and rejections have been overcome and the claims are in condition for allowance, early notice of which is requested. Should the application not be passed for issuance, the examiner is requested to contact the applicant's attorney to resolve the problem.

Appl. No. 10/777,652  
Amdt. dated June 29, 2005  
Reply to Office action of March 31, 2005

Respectfully submitted,

Date: June 29, 2005

*Fei-Fei Chao*

Fei-Fei Chao, Ph.D. (Reg. No. 43,538)  
Bingham McCutchen LLP  
Three Embarcadero Center, Suite 1800  
San Francisco, California 94111-4067  
Tel.: (202) 778-3179  
Fax: (202)-778-6155